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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,542	05/26/2000	Cheng Chung Lin	TSMC2000-079	7369

7590 03/21/2002
George O Saile
20 McIntosh Drive
Poughkeepsie, NY 12603

EXAMINER

VINH, LAN

ART UNIT	PAPER NUMBER
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1765

DATE MAILED: 03/21/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/579,542

Applicant(s)

LIN ET AL.

Examiner

LAN VINH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 9 and 14 is/are rejected.
- 7) ☒ Claim(s) 2-8, 10-13, 15-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 9, 14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Amended claims 1, 9, 14 recite the limitation of "with no intervening step".

However, the examiner is not able to find the support for the limitation of "with no intervening step" in the specification of the instant application. If the applicants disagree with the examiner rejection, the applicants are requested to provide the pages and column numbers in the specification wherein the support for the above-mentioned limitation can be located.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 5, 10, 9, 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In lines 1 and 8 of claim 1, line 1 of claims 5 and 10, lines 1 and 18 of claim 9, line 2 of claim 13, the use of the term "predetermined " is vague and indefinite because a claim is indefinite where it specifies "predetermined" temperatures, etc..., when "predetermined" according to applicant's definition, merely means determined before hand. See *Seagrams & Sons Inc., vs Mattell*, 84 U.S.P.Q 180. therefore, the claim(s) is/are unpatentable under 35 U.S.P.Q. 112 second paragraph. The examiner suggests deleting the term "predetermined".

5. Claims 2-8, 10-13, 15-20 are objected to as being dependent upon a rejected base claim

Response to Argument

6. The rejections of claims 2, 9, 14, 18 under 35 U.S.C. & 112 regarding the term "black diamond" as detailed in paper no.4 have been withdrawn in view of the response filed on 1/10/2002. However, applicant's arguments regarding the term "predetermined" have been fully considered but they are not persuasive. In traversing the examiner rejection of the indefinite term "predetermined", the applicants argue that it is often the case that the thickness that is deposited is indirectly determined by the value of some other quantity other than thickness itself (i.e sheet resistance value), by qualifying the thickness as "predetermined" the applicants exclude indirect thickness value of this type. The examiner disagrees because the term "predetermined thickness " simply means the thickness is determined beforehand, the term "predetermined thickness " does

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not necessarily means that the thickness that is deposited is determined by the quantity of the thickness itself. Therefore, the examiner asserts that claims 1, 5, 10, 9, 13 is/are unpatentable under 35 U.S.P.Q. 112 second paragraph. Applicant's arguments with respect to claimed rejection under 35 U.S.C & 103 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

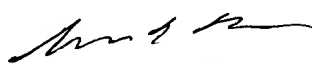
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Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAN VINH whose telephone number is 703 305-6302. The examiner can normally be reached on Monday-Friday 8:30 -6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BENJAMIN L UTECH can be reached on 703 308-3836. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9310 for regular communications and 703 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.


BENJAMIN L. UTECH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

LV
March 19, 2002